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55. (Amended) The smoking article of Claim [5] 52 wherein said population of smoking articles is a grab sample of smoking articles.

142. (Amended) The method according to claim [131 further including] 132 wherein treating includes treating with a composition that includes a filler.

144. (Amended) The method according to claim [131] 132 further including at least one of reducing and redistributing said at least one ingredient in paper by a variety.

Remarks

The Office Action objected to claims 144-146 as being improperly dependent. These have been corrected above, and an additional similar correction has been made to claim 55.

The other claims were rejected as being directed to an invention that would have been obvious to a person of ordinary skill in the art from the disclosure of U.S. Patent 5,878,753 to Peterson et al. in view of the disclosure of U.S. Patent 4,302,252 to Turbak et al. The Office Action acknowledges that the Peterson reference does not disclose the composition applied in Applicant's invention and cites Turbak for such a solvent and cellulose system. The Office Action asserts that the motivation to use the Turbak system on smoking articles like Peterson's comes from a passage of Peterson that the Office Action describes as "does teach that all natural polymers/cellulosic polymers which are soluble in non-aqueous solutions form suitable permeability reducers for its cigarette wrappers."

In looking at the Peterson reference, column 4, lines 22-64 more closely, one sees that the passage is not a motivation to use something like what Turbak discloses, but rather merely a patentee's "unlimiting" statement. The invention being protected in the Peterson et al.

patent is a ramp, or "gradually decreasing permeability profile." This ramp is seen in Figures 5, 6A and 6B of the Peterson et al reference. The passage relied upon by the Office Action merely says that the materials are not critical to whether or not the Peterson et al invention is being used. In other words, to the extent that Peterson refers to solvent systems other than those he specifically endorses, he says that their use with his ramp would amount to use of his invention. This is not a suggestion or motivation to use the Turbak et al solvent system. Rather, it is a statement that if subsequent to the issuance of the Peterson et al. patent, someone were to come up with a new invention using another solvent system (Peterson makes no indication that he has any awareness whatever of Turbak's system) with the ramps of Peterson et al, Peterson would claim that to be an infringement. Such "unlimiting" statements are not the type of statements that provide the motivation required to support a section 103 rejection. *In re Benno*, 226 USPQ 683 (Fed. Cir. 1985). Similarly, in *Fromson v. Anitec Printing Plates, Inc.*, 132 F. 3d 1437, 45 USPQ 2d. 1269 (Fed. Cir. 1997) the Court said that a reference having a boilerplate statement that other "suitable" liquids can be used is insufficiently specific to suggest the patentee's claimed invention. That is like the case here, where unlimiting statements in Peterson's patent do not amount to a motivation.

Of course, the Examiner is well aware of the fact that a suggestion to combine is, in fact required in order to make an obviousness rejection. *In re Dembiczak*, 50 USPQ 2d 1614 (Fed. Cir. 1999)

Thus, the rejection of the claims is based on a faulty premise and should be withdrawn. This includes the rejections based on Peterson and Turbak and those adding the Timpa or Hotaling references. Those references do not provide the motivation that is lacking in basic combination.

In addition, claims 7-16, 53-69, 149 and 150 specify a population of smoking articles having one or more banded regions, with at least one of the banded regions of each smoking article being at a location that is one of random, quasi random and sequentially related within the population. None of the references show such relationships. The office action cited Peterson column 5, lines 63-65 for this proposition, but one of ordinary skill in the art would interpret this passage of Peterson as nothing but putting all bands of a population of smoking articles having the same variables at the same location. Thus, the rejection of these claims as being obvious is improper and should be withdrawn.

It is believed this case is now in condition for allowance and same is earnestly solicited. Should the Examiner having any small matters requiring resolution, she is encouraged to telephone the undersigned for expeditious handling.

Respectfully submitted,



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Date: September 16, 2002
File No.: 4800-091

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